

## REMARKS

Applicant is canceling claims 8 and 9, without prejudice. Therefore, claims 1-7 currently are pending in the above-captioned patent application and are subject to examination. Reconsideration of the above-captioned patent application is respectfully requested in view of the foregoing amendments and the following remarks.

In the Office Action mailed April 26, 2004, the Examiner provisionally rejected claims 1-7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over each of U.S. Patent No. 6,477,526 to Hayashi *et al.* ("Hayashi") and U.S. Patent No. 6,532,475 to Nakano *et al.* ("Nakano"). The Examiner also rejected claims 1-9 under 35 U.S.C. § 103(a), as being rendered obvious by U.S. Patent No. 6,263,343 to Hirono in view of U.S. Patent No. 5,948,040 to DeLorme *et al.* ("DeLorme"). Applicant respectfully traverses these rejections.

### 1. Double Patenting Rejections

The Examiner provisionally rejected claims 1-7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over each of Hayashi and Nakano. Applicant respectfully disagrees.

Specifically, each of Hayashi and Nakano are related to a map information providing system for route calculation, and neither of these patents disclose or suggest a map database site equipped with a database which is configured to perform the functions performed by Applicant's claimed retrieval database. Therefore, Applicants respectfully request that the Examiner withdraw the double patenting rejections.

2. 35 U.S.C. § 103(a)

The Examiner rejected claims 1-9 under as being rendered obvious by Hirono in view of DeLorme. In order for the Examiner to establish a prima facie case for obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the primary reference as the Examiner proposes. Second, there must be a reasonable expectation of success in connection with the Examiner's proposed combination of the references. And third, the prior art references must disclose or suggest all of the claim limitations. MPEP 2143 (emphasis added.) For the reasons set forth below, Applicants submit that the Examiner fails to establish a Prima Facie case for obviousness.

Applicant's independent claim 1 describes a map providing system comprising a "map-information providing site [which] has a map-information providing server for displaying the information providing screen for making the designation entry for the request to provide the map image to the information terminal," and a "map database site [which] has a map-information database storing map image data, [and] a retrieval database storing retrieval data for retrieving the map image data corresponding to said designation entry from said map-information database."

For example, as set forth in dependent claim 2, the retrieval data stored in the retrieval database may comprise "position data representing the correspondence between the designation entry translated into said required information form and